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Paper #16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Anthony J. Antonious

Group Art Unit: 3711

Serial No.: 09/545,111

Examiner: Passaniti

Filed : 04/06/00

Title : GOLF CLUB SHAFT AND INSERT THEREFOR (Reissue of USP 5,735,752)

APPEAL BRIEF

Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Sir:

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REAL PARTY IN INTEREST

Adams Golf IP, LP is the real party of interest in the above referenced patent application.

RELATED APPEALS AND INTERFERENCES

Neither Appellant's representative nor Appellant's assignee is aware of any related appeals and/or interferences affected by or having a bearing on the Board's decision in the pending appeal.

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## STATUS OF CLAIMS

Claims 1-41 and 63-72 are currently pending in the above-referenced application (based upon the Amendment After Final Rejection filed October 30, 2001 for which an Office Action has not yet been received, but for which Primary Examiner Passaniti indicated the Amendment After Final Rejection would likely be entered so as to simplify the issues for appeal). Claims 1-41 and 63-72 have been indicated as being allowable over the prior art of record. However, claims 1-41 and 63-72 have been finally rejected by the Examiner.

First, claims 1-41 and 63-72 have been rejected as being based upon a defective reissue declaration due to amendments made during the prosecution of the present application. As the present application is ongoing and future amendments are possible, Appellant respectfully requests that the rejection, and the requirement for a supplemental declaration, be held in abeyance pending the outcome of the present appeal.

In addition to the rejection discussed above, Claims 63-72 stand finally rejected under 35 U.S.C. 251 and Appellant accordingly appeals the Examiner's final rejection of Claims 63-72, which is as follows:

1. Claims 52-62 [currently 63-72 based upon the amendment of October 30, 2001] stand rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for which the present reissue is based.

### STATUS OF AMENDMENTS

An Amendment After Final Rejection was filed October 30, 2001. An Office Action has, however, not yet been received (apparently due the current mail concerns at the U.S. Patent & Trademark Office). However, Primary Examiner Passaniti indicated during an Interview conducted on October 23, 2001 that the Amendment would likely be entered as it simplifies the issues for appeal. With this in mind, Appellant has prepared the present Appeal Brief under the assumption the Amendment After Final Rejection will be entered upon receipt.

## SUMMARY OF THE INVENTION

With reference to Figure 7, an insert 112 is fixed to a conventional shaft 100 of a golf club. The shaft 100 itself is formed of a variety of materials such as steel, graphite, fiberglass, and various alloys and composites, as is known in the art. The insert 112 is formed of a variety of materials and in a variety of shapes and sizes, although certain materials, shapes and sizes are preferred, as will be explained below. (Col. 4, lines 28-40)

The insert has a central section 118 connected at its opposite end to couplers 120 and 122. These couplers fit into or over the shaft 114 or the club head C, in a manner such that a tight fit and strong connection can be made between the insert and the shaft or club head. Preferably, the insert and shaft or club head are permanently fixed to one another through the use of epoxy or a similar adhesive. (Col4, lines 41-58)

Preferably, the insert 112 is constructed in a manner which allows the insert to affect the manner in which the shaft and the entire club responds to torsional forces as the club head is swung and to shocks and vibrations when the ground or ball is hit. The central section of the insert preferably includes physical alterations in its configuration that allow the insert to absorb the shock forces generated when the ball is hit. An insert with such alterations acts as a buffer and/or vibrational dampener or suppressor, thereby reducing or eliminating the transfer of undesirable vibrations and shocks to a golfer's hands. Inserts made of certain materials may be sufficiently resilient to act as a buffer and/or vibrational dampener or suppressor, without physical alteration. (Col. 4, line 66 through Col.5, line 11)

Similarly, the insert preferably includes physical alterations or configurations that allow the insert to twist or turn slightly about its axis when the club head is swung. For example, the insert can include coils or a coil-like configuration providing a feature to control torsion. Thus, on the back swing, the insert undergoes a controlled coiling action that in effect produces stored energy in

the insert at or about the top of the swing. On the downswing, the built up torsion-force in the insert is uncoiled to develop and impart an additional torsion, propulsion force to the golf ball at impact. (Col. 5, line 12-25)

The insert of the present invention contemplates a number of alternate materials and configurations that provide the desired objects of the invention. For example, it is believed that a wide variety of sizes and shapes of inserts, including a relatively simple cylindrical central section, will provide the features of the invention regarding the regulation of the desired flex point and swing weight of a golf club. More complex designing is necessary to achieve the preferred combined features of swing weight regulation, shock cushioning, torsion control, and flex and stiffness regulation. By means of example, the central section 118 can be machined to include a plurality of spaced coils or bands, rather than a helical configuration. Such an insert can be either machined or molded. It is further possible that an insert can be formed of special materials that provide the desired absorption and torsion characteristics through a cylindrical central section, with or without a bore. (Col. 6, lines 35-57)

As shown in FIG. 7, the insert 112 is positioned directly adjacent the hosel of a club head 124. The insert 112 in accordance with the embodiment disclosed with reference to Figure 7 is preferably machined from titanium. This embodiment has proven to provide excellent shock absorption characteristics, particularly for irons. While the placement of the insert at or near the club head adds to the swing weight of a given club, it also places more mass close to the ball, for greater force for a given acceleration at impact. (Col. 7, lines 14-30)

FIG. 18 illustrates another embodiment of the present invention wherein a shaft insert 412 includes a solid central section 418. Such insert can be made of a variety of materials and can be either a one-piece construction or a multi-piece construction. For example, an insert having this configuration, and made of a relatively rigid material such as steel or titanium, would produce the

swing weight and flex control features of the invention but would likely not absorb shock or control or generate torsion forces. On the other hand, an inset having this configuration but made in whole or in part from a material having certain resilient qualities could possibly provide each of these four features and still provide the necessary strength, semi-rigidity, and control. For example, this embodiment may be made from a Lexan or fiberglass composite. (Col. 7, line 61 through Col. 8, line 8)

### ISSUE

1. Whether claims 63-72 stand properly rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for which the present reissue is based?

### GROUPING OF THE CLAIMS

Claims 63-72 stand or fall together.

## ARGUMENTS

### I. CLAIMS 63-72 DO NOT CONSTITUTE AN IMPROPER RECAPTURE OF BROADENED CLAIMED SUBJECT MATTER SURRENDERED IN THE APPLICATION FOR WHICH THE PRESENT REISSUE IS BASED

As discussed above, the outstanding rejection contends that claims 52-61 [currently 63-72 based upon the amendment of October 30, 2001] stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based. Specifically, the rejection properly points out that the specific phrase “‘at least as rigid as the tubular section’ . . . [was] part of the language added to the claims and argued by the applicant to specifically overcome the rejections of the original claims and to place the claims in condition for allowance.” Reference to independent claims 1 and 30 shows the manner in which the phrase “at least as rigid as the tubular section” is used in the claims previously issued in U.S. Patent No. 5,735,752.

The outstanding rejection is correct in stating that Appellant may not recapture subject matter intentionally given up during the prosecution of a patent application. However, the facts of the present reissue application do not support a conclusion that claims 63-72 amount to an improper recapture of subject matter given up during the prosecution of the preceding patent application. Rather the facts of the present reissue application show that Appellant is seeking to obtain patent coverage for that which was inadvertently overlooked during the prosecution of the original patent application.

Claims 63 and 68 generally define a golf club shaft very different from the shafts considered during the prosecution of the original application. For example, claims 63 and 68 generally claim a golf club shaft having a distal end and butt end. The shaft includes a tubular section having a first end located at the butt end of the golf club shaft and a second end positioned slightly short of the distal end of the golf club shaft. The shaft further includes a unitary insert secured to the second end of the tubular section. The insert is shorter than the tubular section and extends from the



second end of the tubular section to the distal end of the golf club shaft. The insert includes a tubular first end securely coupled to the second end of the first member and a tubular second end shaped and dimensioned for secure attachment within a hosel of a golf club head. The insert is formed from a vibration absorbing material which absorbs undesirable vibrations resulting from an individual striking a golf ball (claim 63) or a material controlling the stiffness at the distal end of the golf club shaft upon striking a golf ball to thereby stabilize a golf club head secured to the distal end of the golf club shaft (claim 68).

Briefly, the only limitation from the allowed patent claims at issue with respect to the newly submitted claims relates to the rigid nature of the insert relative to the tubular section. As such, the only question at issue in the present application appears to be whether Appellant is entitled to broaden the reissue claims by removing reference to the rigid nature of the insert relative to the tubular section, but add additional limitations to the exact position of the insert and the material characteristics of the insert.

Specifically, claims 63 and 68 are narrower in many respects than the claims originally considered and as such are not believed to constitute a recapture of subject matter given up during prosecution of the present application. For example, claims 63 and 68 define "a tubular section including a first end located at the butt end of the golf club shaft and [a] second end positioned slightly short of the distal end of the golf club shaft". The original application makes no distinction as to the first end and second end of the tubular section. Presumably, the decision not to include such limitations in the original claims was based upon a desire not to specifically define the position at which the insert must be secured to the shaft; that is, the insert of the originally filed claims could have been secured adjacent the grip or adjacent the club head, while new reissue claims 63 and 68 specifically require that the insert be positioned adjacent the second end of the shaft at a position adjacent the golf club head.

New reissue claims 63 and 68 are further narrower than the originally filed claims in that

they respectively include limitations related to “the insert being formed from a vibration absorbing material which absorbs undesirable vibrations resulting from an individual striking a golf ball” and “the insert being formed from a material controlling the stiffness at the distal end of the golf club shaft upon striking a golf ball to thereby stabilize a golf club head secured to the distal end of the golf club shaft”. These limitation are material to the error which occurred during the prosecution of the original patent application. That is, Appellant failed to appreciate the patentable significance of positioning an insert at the second end of a golf club shaft for achieving vibration absorbance or stabilization of the golf club head.

In addition to the narrowing limitations added to new reissue claims 63 and 68, reissue claims 63 and 68 do not include one limitation added during the prosecution of the present application. That is, limitations relating to the fact that the insert is in fact “at least as rigid as the tubular section”. This features does not relate to the error which occurred during the original prosecution as it has no bearing on an insert formed from a vibration absorbing or stabilizing material which is secured at a second end of the golf shaft adjacent the club head.

Courts have previously considered situations such as the present wherein a reissue claim is broader in some respects and narrower in other respects. In fact, courts have rejected the contention that if a reissue claim is broader in any respect, it necessarily should be deemed broader in all respects and the recapture rule should apply. *Ball Corp. v United States*, 759 F.2d 1429, 1438, 221 U.S.P.Q. 289, 296. (Fed. Cir. 1984). The Federal Circuit, however, limited its decision to situations where the broader aspect of the claim “is not material to the alleged error supporting reissue”. *Id.*

Considering the broadened limitations of reissue claims 63 and 68, it becomes clear that these limitations are not material to the error supporting reissue. Specifically, the error supporting reissue relates to Applicant’s failure to appreciate the significance of securing a vibration absorbing or stabilization insert to the second end of a golf club shaft adjacent the club head. The inclusion of

an insert which is "more rigid" than the tubular section is irrelevant to the alleged error supporting reissue and the recapture rule should not be applied as specified by the Federal Court in *Ball Corp.* Regardless of whether the broadened limitations relating to reissue claims 63 and 68 are material, the U.S. Claims Court, in evaluating *Ball Corp.*, determined "that the recapture rule should not bar a patentee from securing a reissue claim that is broader in a material respect than a canceled claim when, as is potentially the case here, the reissue claim is narrower than the canceled claim in a way that is material to the "error" ". *Patecell v United States*, 16 Cl.Ct. 644, 652, 12 U.S.P.Q. 2d 1440 (Cl.Ct. 1989). The Court in *Patecell* based their decision on the fact that the crucial issue in assessing the significance of narrowing claim limitations on the existence of an error in a reissue application is the intent of the applicant when he or she amended the claim in a narrowing manner. *Ball Corp.*, 729 F.2d at 1436, 221 U.S.P.Q. at 295. The Court in *Patecell* reasoned that

"when the reissue claim is narrower than the canceled claim in a material respect, a similar conclusion as to the patentee's intent [that is, whether the claim was canceled or narrowed based on a deliberate judgment that the claim as originally drafted was unpatentable] and, hence, as to the absence of 'error' cannot be made based exclusively on a comparison of the reissue claim with the canceled claim. Under the patent laws, the fact that a particular claim is unpatentable over prior art does not mean that a claim that is narrow in some respect necessarily also would be unpatentable. The addition of a particular limitation can result in an otherwise unpatentable claim being patentable ... Therefore one cannot presume merely from the act of canceling a claim that a patent applicant made a deliberate judgment that a second claim that is narrower in a certain respect than the canceled claim also would be unpatentable....The conclusion should not change when a second claim, while narrower in at least one respect, is also broader in some respect. The applicant may have agreed with the patent examiner that some original claim was unpatentable but may not have considered, when canceling the claim, that the claim could have been rendered patentable by the addition of a particular limitation. Hence, a deliberate decision to cancel a particular claim because it is unpatentable would not necessarily constitute a deliberate judgment that a claim that is broader in some ways and narrower in others also would be unpatentable."

*Patecell*, 16 Cl.Ct. 644 at 653.

The Court in *Patecell* describes exactly what happened in the present situation. Specifically, the originally filed claims were amended to include limitations relating to the insert "being at least as rigid as said tubular section" in an effort to overcome rejections based upon prior art. However, at the time these amendments were made and the application was placed in condition for allowance,

Appellant did not appreciate the significance of the insert position as it relates to a vibration absorbing element or stabilizing element in a golf club shaft, and made no effort to pursue such claims.

The fact that Appellant amended the original claims in an effort to overcome prior art should, therefore, have no bearing on whether the narrower reissue claims 63-72 would have similarly been considered unpatentable by the Appellant. Had Appellant appreciated the significance of claims defining the insert position as it relates to a vibration absorbing element or stabilizing element in a golf club shaft (see claims 63 -72), Appellant most certainly would not have handled these claims in the same manner as claims 1 and 30 of the application as originally prosecuted. Unfortunately, Appellant did not appreciate the significance of claims such as those at issue in the present application, giving rise to the error at issue in the present application.

This error does not amount to a recapture of subject matter given up during the original prosecution, but rather relates to previously unappreciated features of the disclosed invention. It is, therefore, Appellant's opinion that the recapture rule does not apply to claims 63-72 and Appellant respectfully requests that the rejection thereof be withdrawn.

### III. Conclusion

In conclusion, Appellant has now shown that the new claims 63-72 do not improperly recapture subject matter surrendered in the application for the patent upon which the present reissue is based. Therefore, it is respectfully requested that the rejection of claims 63-72 under 35 U.S.C. 251 be reversed.

Respectfully submitted,



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APPENDIX  
CLAIMS ON APPEAL

1. A golf club shaft comprising:  
at least one tubular section; and  
a unitary insert attached to said at least one tubular section for regulating the flex point of said shaft, said insert being shorter than said tubular section and having a central section and a pair of couplers integrally formed on opposite ends of said central section, at least one of said couplers being attached to an end of said tubular section of the shaft and the central section extending axially outwardly away from the end of said tubular section, said insert being at least as rigid as said tubular section.
2. The shaft of claim 1 being further defined by two tubular sections,  
a first lower tubular section forming a tip end of said shaft for attachment to the golf club head and an upper tubular section forming a butt end for attachment of a grip; wherein one of said couplers is attached to said lower section and the other said coupler is attached to said upper section.
3. The shaft of claim 2 wherein said couplers are female connectors.
4. The shaft of claim 3 wherein said couplers are male shank connectors.
5. The shaft of claim 3 wherein said couplers include one male shank connector and one female connector.

6. The shaft of claim 2 wherein a grip is attached to said upper section and said insert is located within 5 inches of said grip.
7. The shaft of claim 6 wherein a grip is attached to said upper section and said insert is located within 2 inches of said grip.
8. The shaft of claim 1 wherein said central coil is formed in a series of annular rings.
9. The shaft of claim 1 wherein one of said couplers is connectable directly to the golf club head.
10. The shaft of claim 1 wherein said central section of the insert includes a plurality of helically shaped coils.
11. The shaft of claim 10 wherein said plurality of coils are surface coils formed on the surface of said central section.
12. The shaft of claim 10 wherein said plurality of coils are formed by a continuous elongated member, forming a spring-like element.
13. The shaft of claim 1 wherein said insert is made from titanium.
14. The shaft of claim 13 wherein said central section includes a plurality of helically shaped coils.

15. The shaft of claim 14 wherein said central section includes no more than 5 coils.
16. The shaft of claim 15 wherein said insert includes a hollow central bore extending along its length.
17. The shaft of claim 16 wherein said central section is no more than 1.00 inches long and said couplers are no more than 1.5 inches long.
18. The shaft of claim 1 wherein said insert includes a means for absorbing shock and cushioning vibration when a shot is executed.
19. The shaft of claim 1 wherein said insert includes a means for controlled turning about its axis in response to the torque developed by the club as it is swung.
20. The shaft of claim 1 wherein said insert includes a means for absorbing shock and cushioning vibration when a shot is executed, and for controlling turning about its axis in response to the torque developed by the shaft as it is swung.
21. The shaft of claim 1 wherein said insert includes physical alterations that allow the insert to twist or turn slightly about its axis when the club head is swung.
22. The shaft of claim 1 wherein said insert is more rigid than said tubular section of the shaft.
23. The shaft of claim 1 wherein said insert includes physical alterations in its configuration which allow the insert to absorb shock and cushion vibration when a shot is executed.



24. The shaft of claim 23 wherein said physical alterations include a hollow, central bore throughout the length of said insert.

25. The shaft of claim 23 wherein said physical configurations comprise a coil structure formed on the surface of at least a portion of said insert.

26. The shaft of claim 25 wherein said insert is more rigid than said tubular section of the shaft.

27. The shaft of claim 25 wherein said coils are in the form of an arcuate bead formed on the surface of at least the central portion of said insert.

28. A golf club shaft comprising:

at least one tubular section; and

a unitary insert attached to said at least one tubular section for regulating the flex point of said shaft; said insert being shorter than said tubular section and having a central section and a pair of couplers integrally formed on opposite ends of said central section, at least one of said couplers being attached to an end of said tubular section of the shaft and the central section extending axially outwardly away from the end of said tubular section, said insert including physical alterations that allow the insert to twist or turn slightly about its axis when the club head is swung.

29. The golf club of claim 28 wherein said insert is attached to the club head at one end and to the shaft at the other end.

30. A golf club comprising:  
a golf club head;  
a shaft having upper and lower tubular sections, one tubular section connected to the golf club head and the other tubular section connected to a grip; and  
means for regulating the swing weight, flex point, and stiffness of the club, said means including a unitary insert having a central section and a pair of couplers integrally formed on opposite ends of said central section, one coupler attached to the upper tubular section of the shaft and the other coupler attached to the lower tubular section of the shaft, said insert being at least as rigid as said tubular sections.
31. The golf club of claim 30 wherein said insert includes a means for controlling turning about its axis in response to the torque developed by the club as it is swung.
32. The golf club of claim 30 wherein said insert is located within 3 inches of the club head.
33. The golf club of claim 30 wherein said insert is located in the upper half of the shaft.
34. The golf club of claim 30 wherein said insert is located in the upper third of the shaft.
35. The golf club of claim 30 wherein said insert is located adjacent the grip of said clubs.
36. The golf club of claim 30 wherein said central section of said insert includes a plurality of coils.
37. The golf club of claim 30 wherein said insert is configured to absorb shock.

38. The golf club of claim 30 wherein said insert has physical alterations along at least a portion of its surface, said alterations suppressing vibration along the shaft.

39. The golf club of claim 38 wherein said insert includes a bore throughout its length to enhance the vibration-suppression of the insert.

40. The golf club of claim 39 wherein said insert is more rigid than the shaft.

41. The golf club of claim 30 wherein said insert is shorter than said tubular section and the central section of said insert extends outwardly away from opposite ends of said tubular sections.

63. A golf club shaft having a distal end and butt end, comprising:

a tubular section including a first end located at the butt end of the golf club shaft and a second end positioned slightly short of the distal end of the golf club shaft;

an unitary insert secured to the second end of the tubular section, the insert being shorter than the tubular section, the insert extends from the second end of the tubular section to the distal end of the golf club shaft and includes a tubular first end securely coupled to the second end of the first member and a tubular second end shaped and dimensioned for secure attachment within a hosel of a golf club head;

the insert being formed from a vibration absorbing material which absorbs undesirable vibrations resulting from an individual striking a golf ball.

64. The golf club shaft according to claim 63, wherein the tubular section is made from a material chosen from the group consisting of steel, graphite and fiberglass.

65. The golf club shaft according to claim 63, wherein the insert is made from a lexan or fiberglass composite.

66. The golf club shaft according to claim 63, wherein the insert is made from titanium.

67. The golf club shaft according to claim 63, wherein the insert includes a central section and a pair of couplers formed on opposite ends of the central section, the central section being approximately 0.5 inch in length.

68. A golf club shaft having a distal end and butt end, comprising:

a tubular section including a first end located at the butt end of the golf club shaft and a second end positioned slightly short of the distal end of the golf club shaft;

a unitary, semi-rigid insert secured to the second end of the tubular section, the insert being shorter than the tubular section, the insert extends from the second end of the tubular section to the distal end of the golf club shaft and includes a tubular first end securely coupled to the second end of the first member and a tubular second end shaped and dimensioned for secure attachment within a hosel of a golf club head;

the insert being formed from a material controlling the stiffness at the distal end of the golf club shaft upon striking a golf ball to thereby stabilize a golf club head secured to the distal end of the golf club shaft.

69. The golf club shaft according to claim 68, wherein the tubular section is made from a material chosen from the group consisting of steel, graphite and fiberglass.

70. The golf club shaft according to claim 68, wherein the insert is made from a lexan or fiberglass composite.

71. The golf club shaft according to claim 68, wherein the insert is made from titanium.
72. The golf club shaft according to claim 68, wherein the insert includes a central section and a pair of couplers formed on opposite ends of the central section, the central section being approximately 0.5 inch in length.